IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Fano, Andrew E., et al.	Examiner: Peng, Fred H.
Application No.: 10/826,227	Group Art Unit: 2623
Filed: April 16, 2004	Docket No.: 33836.00.0046
For: **CONTROLLED MULTI-MEDIA** **PROGRAM REVIEW**	Confirmation No. 9661

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

Dear Sir:

Appellants submit this brief in furtherance of the Notice of Appeal filed on November 17,

2008 in connection with the above-identified application.

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I.   Real Party in Interest

Accenture Global Services, GmbH is the real party in interest in this appeal by virtue of an executed Assignment from the named Inventors of their entire interest to Accenture Global Services, GmbH.   The Assignment evincing such ownership interest was recorded on September 2, 2004, in the United States Patent and Trademark Office at Reel 015792, Frame 0614.

II.   Related Appeals and Interferences

To Appellants' knowledge, there are no related Appeals or Interferences filed, pending, or decided.

III.   Status of Claims

The originally filed Application contained claims 1-44. Claims 20, 22-24, 36-37, 39, and 42-44 were canceled. Claims 1, 3, 4, 11, 12, 14-19, 25-35, 38, and 41 were amended during prosecution of the instant application. Claims 1-19, 21, 25-35, 38, 40 and 41 are rejected. No claims have been allowed and there are no objections to the claims. A copy of the appealed claims 1-19, 21, 25-35, 38, 40 and 41 are attached at <u>Appendix A</u>. Of the pending, appealed claims, claims 1 and 38 are independent.

IV.   Status of Amendments

A non-final Office Action was mailed February 5, 2008. In response, an Amendment and Response was filed by Appellants on May 1, 2008 amending claims 1, 3, 4, 11, 12, 14-19, 25-35, 38, and 41. A final Office Action was subsequently mailed August 20, 2008 (the "Final Office Action"). No amendments to the claims have been made subsequent to the Final Office Action, and the claims listed in Appendix A reflect the claims as they stood at the time the Final Office Action was mailed.

V.   Summary of Claimed Subject Matter

Independent claim 1 concerns a method for playback of multi-media program material (see e.g., FIG. 7) comprising segments (FIG. 2, lines 1-4 of paragraph [0023]). The method includes playing back from the multi-media program material, a first segment of the multi-media program material selected according to a first criteria that is defined according to content of the multi-media program material. (page 6, lines 7-10 of paragraph [0031]). The method also includes suppressing playback of a second segment of the multi-media program material (page 4, lines 5-6 of paragraph [0023]; see also page 6, lines 4-7, 10-11 of paragraph [0031]) selected according to a second criteria that is defined according to the content of the multi-media program material (page 4, lines 6-8 of paragraph [0023]). Further, the method includes playing back, from the multi-media program material, a third segment of the multi-media program material selected according to the first criteria (page 6-7, lines 14-17 of paragraph [0031]).

Independent claim 38 is directed to an apparatus for play back of multi-media program material comprising segments that includes a multi-media playback unit 1002. (FIGS. 10 and 12, element 1002, page 19, lines 1-2 of [0086]). The multi-media playback unit 1002 is capable of selectively playing back segments of the a multi-media program material. (page 19, paragraph [0089]). The apparatus also includes a memory 1212 that stores program instructions. (FIG. 12 at element 1212, page 19, lines 4-6 of paragraph [0087]). A first controller 1210 is operatively coupled to the multi-media playback unit 1002 and to the memory 1212 such that the controller 1210 is operable to cause the apparatus, when executing the program instructions, to play back, from the multi-media program material, a first segment of the multi-media program material selected according to a first criteria that is defined according to content of the multi-media program material. (page 6, lines 7-10 of paragraph [0031]). The controller also causes the apparatus to suppress playback of a second segment of the multi-media program material (page

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4, lines 5-6 of paragraph [0023]; see also page 6, lines 4-7, 10-11 of paragraph [0031]) selected according to a second criteria that is defined according to the content of the multi-media program material (page 4, lines 6-8 of paragraph [0023]) and to play back, from the multi-media program material, a third segment of the multi-media program material selected according to the first criteria (page 6-7, lines 14-17 of paragraph [0031]).

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VI.   Grounds of Rejection to be Reviewed on Appeal

Claims 1-7, 9-15, 25, 26, 28-31, 34, 35 and 38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/00356648 to Lopez-Estrada et al. (hereinafter "Lopez-Estrada). Claims 8, 18-19, 21 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopez-Estrada. Claims 16, 17 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopez-Estrada in view of U.S. Patent No. 6,947,573 to Linnartz. Claims 32, 40 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopez-Estrada in view of U.S. Patent No. 5,410,326 to Goldstein.

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VII. Argument

A.   Claims 1-19, 21, 25-35, 38, 40 and 41

    1.   The 35 U.S.C. § 102(e) Anticipation Rejections Must Be Reversed Because The Cited Reference Fails To Teach All Of The Claim Limitations As Alleged

Anticipation under 35 U.S.C. § 102 occurs "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (M.P.E.P. § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

As to independent claims 1 and 38, Appellants recite, among other things, "playing back ... a first segment of the multi-media program material selected according to a first criteria that is defined according to the content of the multi-media program material", "suppressing playback of a second segment ... selected according to a second criteria that is defined according to the content of the multi-media program" and "playing back ... a third segment of the multi-media program material selected according to the first criteria". Appellants respectfully submit that Lopez-Estrada fails to teach, disclose or suggest these features. As best understood, Lopez-Estrada simply uses predefined criteria that is external to the MPEG stream and/or the content analysis module 43 (see e.g., FIG. 2D, lines 11-16 of paragraph [0023]), wherein such predefined criteria is not particular or customizable according the viewer's content interests or preferences.

Lopez-Estrada is directed to navigation in digitized video and/or audio data streams wherein navigation information can be generated from compressed and packetized MPEG streams. (See Abstract). An authoring tool may be used to parse the MPEG stream and generate the navigation data. (See Abstract). In paragraph [0010] on lines 10-15, Lopez-Estrada discloses that the navigation data may be data that permits selective retrieval of portions of the MPEG stream for playback by identifying packets or other portions of the MPEG stream that are

associated with navigation points, i.e., points in the presentation that the user may wish to access quickly and begin playing. In FIG. 1B, Lopez-Estrada discloses a block diagram of an end-to-end system 2 in which a navigation database is generated automatically by monitoring the MPEG stream and identifying the desired points in the MPEG stream based on predefined criteria. See also, lines 1-5 in paragraph [0014] of Lopez-Estrada. In paragraphs [0012] and [0014], Lopez-Estrada discloses that the encoder 10 performs the functions of receiving, compressing, packetizing, and multiplexing; that the navigation generator 40 analyzes the content of the MPEG stream to generate the navigation database; and that the decoder/player 30 may select various portions of the MPEG stream for playback, based on the data in the navigation database.

As a result, the navigation points stored by the process of Lopez-Estrada have no ties to the semantic content of the MPEG streams and are instead tied to external criteria. For example, in FIG. 2D and lines 8-18 of paragraph [0023], Lopez-Estrada discloses that in the navigation generator 40, the content analysis module 43 may examine the video and/or audio content in the MPEG stream to determine what presentation times should be used for navigation points. In paragraph [0020], Lopez-Estrada discloses an embodiment concerning manual selection of navigation points, wherein the navigation points can be selected by the user as "specified amounts of time after [the MPEG stream] starts, or may be points that divide the movie into a specified number of equal time segments." The content analysis module 43 may use pattern recognition techniques to examine the MPEG stream and note which packets meet predefined criteria that have been provided to the content analysis module 43. See e.g., lines 11-18 of paragraph [0023]. More particularly, the content analysis module 43 may search the I-frames for the totally dark frames that occur between two scenes in a movie. Note that totally dark I-frames are not related to the actual content of the movie.

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Lopez-Estrada, thus, appears to merely teach a system in which a user is offered bookmarking or chapter references that permit constrained viewer navigation and control by offering only limited viewer control of content playback, usually according to predetermined criteria that is not particular or customizable according to the viewer's content interests or preferences. See e.g., lines 22-30 in paragraph [0023] of Lopez-Estrada. This approach, as disclosed in Lopez-Estrada, is essentially equivalent to those approaches described in the "Background of the Invention" section of the instant application when discussing the limitations of devices that "offer bookmarking or chapter references that permit some degree of viewer navigation and control of content on playback."

Moreover, as stated above, independent claims 1 and 38, Appellants recite, among other things, "suppressing playback of a second segment ... selected according to a second criteria that is defined according to the content of the multi-media program". Lopez-Estrada fails to teach, disclose or suggest this feature.

The Office Action cites paragraphs [0022], lines 8-14 and paragraphs [0023], lines 22-30 of Lopez-Estrada as teaching "suppressing playback of a second segment ... selected according to a second criteria that is defined according to the content of the multi-media program." Instead, in lines 8-14 of paragraphs [0022], Lopez-Estrada discloses ways in which playback stack 31 may read a navigation file that indicates where in the MPEG stream various segments of the presentation are located. By combining the segment requests from playback control 33, and the navigation files identifying where in the MPEG stream/database those requested segments may be located, the selected MPEG segments may be read and presented to decoder 32, where they may be decoded and played. Merely locating segments to be read and played as disclosed in Lopez-Estrada does not correspond to "suppressing playback of a second segment ... selected

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according to a second criteria that is defined according to the content of the multi-media program" as recited by Appellants in claims 1 and 38.

Further, in lines 22-30 of paragraphs [0023], Lopez-Estrada discloses a technique that may be combined with other criteria to identify desirable breaks in the presentation. As an example, Lopez-Estrada discloses that if it is desirable for commercial reasons to find a natural break in a TV movie that is between 18 and 23 minutes into the presentation, the dark frames separating two scenes may be searched for between those two times in the MPEG stream, and the identification of one of those dark frames may be designated as the start of a new chapter. This permits easy insertion of a commercial into that break. Merely searching and locating dark frames between two times in an MPEG stream, and then inserting information in the located frames fails to correspond "suppressing playback of a second segment ... selected according to a second criteria that is defined according to the content of the multi-media program" as recited in claims 1 and 38. Indeed, nowhere in the cited prior art does Lopez-Estrada disclose, teach or suggest the concept of "suppressing playback of a second segment ... selected according to a second criteria that is defined according to the content of the multi-media program" as recited by Appellants in claims 1 and 38.

Therefore, Appellants' respectfully submit that Lopez-Estrada fails to teach, disclose or suggest the use of criteria that are defined according to the content of the multi-media program material, i.e., that are content specific. Instead, the predefined criteria, as used in Lopez-Estrada, is not particular or customizable according the viewer's content interests or preferences. Thus, to the extent that Lopez-Estrada fails to teach, disclose or suggest "playing back ... a first segment of the multi-media program material selected according to a first criteria that is defined according to the content of the multi-media program material", "suppressing playback of a

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second segment ... selected according to a second criteria that is defined according to the content of the multi-media program" and "playing back ... a third segment of the multi-media program material selected according to the first criteria", as recited in claims 1 and 38, Appellants respectfully submit that the rejection is improper and should be reversed.

Further, dependent claims 2-19, 21, 25-35, 40 and 41 are dependent upon, and therefore include the limitations of, claims 1 and 38. For this reason, Appellants respectfully submit that claims 2-19, 21, 25-35, 40 and 41 are in condition for allowance for at least the same reasons presented above relative to claims 1 and 38, and the rejection should be reversed.

    2.   The 35 U.S.C. § 103(a) Obviousness Rejections Must Be Reversed Because The Cited References Do Not Establish Prima Facie Obviousness As Alleged

A claim is obvious under the Patent Act "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a) (2004) "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." (M.P.E.P. § 2143.03, citing *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974)).

Claims 8, 18, 19, 21 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopez-Estrada. The rejections of these claims take Official Notice that the various limitations cited therein are well-known in the art and would have been obvious to combine with the teachings of Lopez-Estrada. While Appellants traverse these assertions, they further note that claims 8, 18, 19, 21 and 33 are dependent upon, and therefore include the limitations of, claim 1. Thus, to the extent that claim 1 includes limitations (described above) not taught by Lopez-Estrada or the Officially Noticed materials, Appellants respectfully submit

that the combination of Lopez-Estrada in view of the Officially Noticed materials fails to establish prima facie obviousness of claims 8, 18, 19, 21 and 33. Therefore, the rejection of claims 8, 18, 19, 21 and 33 should be reversed.

Claims 16, 17 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopez-Estrada in view of Linnartz. In particular, it is asserted that it would have been obvious to combine the insertion of watermarks in multi-media signals as taught by Linnartz with the teachings of Lopez-Estrada in order to obtain the benefit of "right[s] protection and revenue increase." While Appellants traverse these assertions, they further note that claims 16, 17 and 27 are dependent upon, and therefore include the limitations of, claim 1. Thus, to the extent that claim 1 includes limitations (described above) not taught by Lopez-Estrada or Linnartz, Appellants respectfully submit that the combination of Lopez-Estrada in view of Linnartz fails to establish prima facie obviousness of claims 16, 17 and 27. Therefore, the rejection of claims 16, 17 and 27 should be reversed.

Claims 32, 40 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopez-Estrada in view of U.S. Patent No. 5,410,326 to Goldstein. In particular, it is asserted that it would have been obvious to combine the wireless remote controller capable of displaying segments provided to the wireless remote controller of Goldstein with the teachings of Lopez-Estrada in order to obtain the benefit of "added convenience." While Appellants traverse these assertions, they further note that claims 32, 40 and 41 are dependent upon, and therefore include the limitations of, claims 1 and 38, respectively. Thus, to the extent that claims 1 and 38 include limitations (described above) not taught by Lopez-Estrada or Goldstein, Appellants respectfully submit that the combination of Lopez-Estrada in view of Goldstein fails to establish prima facie

obviousness of claims 32, 40 and 41. Therefore, the rejection of claims 32, 40 and 41 should be reversed.

VIII. Conclusion

For the reasons advanced above, Appellant submit that the Examiner erred in rejecting pending claims 1-19, 21, 25-35, 38, 40 and 41 and respectfully request reversal of the decision of the Examiner.

Respectfully submitted,

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APPENDIX A

CLAIMS ON APPEAL

1.   A method for playback of multi-media program material comprising segments, the method comprising:

playing back from the multi-media program material, a first segment of the multi-media program material selected according to a first criteria that is defined according to content of the multi-media program material;

suppressing playback of a second segment of the multi-media program material selected according to a second criteria that is defined according to the content of the multi-media program material; and

playing back, from the multi-media program material, a third segment of the multi-media program material selected according to the first criteria.

2.   The method of claim 1 wherein said first criteria and said second criteria are comprised of indexes within said multi-media program material.

3.   The method of claim 1 wherein said first criteria is comprised of an index that identifies at least one of: a beginning and an end of a segment within said multi-media program material.

4.   The method of claim 1 wherein suppressing the playback of the second segment further comprises:

playing multi-media program material until a first index is located;

while said first segment is played back, locating a second index in said multi-media program material; and

at the conclusion of the play back of the first segment, playing back multi-media content after said second index.

5.   The method of claim 1 wherein said second segment is ordered after said first segment and said third segment is ordered after said second segment in said multi-media program material.

6.   The method of claim 1 wherein said third segment is ahead of said first segment in said multi-media program material.

7.   The method of claim 1 wherein said first segment selected for playback includes a segment of video of a first portion of said multi-media program material and a segment of audio of a second portion of said multi-media program material.

8.   The method of claim 1 wherein said multi-media program material is comprised of at least one of a televised sporting event.

9.   The method of claim 1 wherein said first criteria includes a user's preferences to playback predetermined content.

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10.   The method of claim 1 wherein said first criteria includes a user's specified playback time of said multi-media program material.

11.   The method of claim 1, further comprising:

viewing said multi-media program material;

identifying content segments in said multi-media program material that conform to at least one criteria; and

indexing said content segments by adding an index in said multi-media program.

12.   The method of claim 1, further comprising:

viewing said multi-media program material; and

annotating said multi-media program material.

13.   The method of claim 1 wherein said first criteria includes at least one of:

detecting an image depicted in said multi-media program material;

detecting an audio signal in said multi-media program material.; and

detecting a camera angle at which content in said multi-media program material was captured;

the presence of user-specified programmatic material in said first segment;

the absence of user-specified programmatic material in said first segment;

subject matter in said multi-media program material;

a viewing angle at which a scene is captured;

a user-specified time period, during which said multi-media program material is to be reviewed; and

predetermined portions of a sporting event.

14.   The method of claim 1 wherein content for display is selected based on data embedded in said multi-media program material.

15.   The method of claim 1 wherein content for display is selected based on data transmitted with said multi-media program material.

16.   The method of claim 1 further comprising: identifying an owner of intellectual property rights in a segment.

17.   The method of claim 16 further comprising determining whether playback of a segment requires compensation to, or from, the owner of the segment.

18.   The method of claim 1 further comprising playing an overlay segment.

19.   The method of claim 18 wherein at least part of said overlay segment comprises at least one of:

semi-transparent video;

opaque video; and

audio.

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21.   The method of claim 18 wherein at least part of said overlay segment is selected by at least one of:

a user's preference; and

a user's input.

25.   The method of claim 11 wherein indexing further comprises adding an annotation that that substantially contemporaneously describes information in said multi-media program material.

26.   The method of claim 11 wherein indexing further comprises embedding an annotation in said multi-media program material that substantially contemporaneous describes content of said multi-media program material.

27.   The method of claim 11 wherein indexing further comprises adding an index by which an owner of a segment can be identified.

28.   The method of claims 25 or 26 further comprising: storing said multi-media program material and said index on a storage media from which said program material can be played back and from which said annotation can be detected.

29.   The method of claim 11 further comprising: transmitting said multi-media program material and said index.

30.   The method of claim 11, further comprising:

detecting a viewer's input control signal to a multi-media playback device;

adding a segment to the multi-media program in response to the user's input control signal; and

responding to the input control signal.

31.   The method of claim 30 wherein the added segment is at least one of:

third party advertising content;

viewer-supplied media; and

an annotation.

32.   The method of claim 30 wherein the added segment is presented on a remote controller for the multi-media playback device.

33.   The method of claim 30 wherein the added segment is presented:

on a predetermined area of a display device on which said multi-media program can be played back, said added segment being presented substantially simultaneously with display of said multi-media program.

34.   The method of claim 30 further comprising:

suspending display of said multi-media program on a display device; and

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displaying said added segment on said display device while the display of said multi-media program is suspended.

35.   The method of claim 30 further including the steps of:

transitioning play back of the first and second segments of said multi-media program; and

playing back said added segment between said first and second segments of said multi-media program.

38.   An apparatus for play back of multi-media program material comprising segments, the apparatus comprising:

a multi-media playback unit, capable of selectively playing back segments of the multi-media program material;

a memory wherein program instructions are stored;

a first controller, operatively coupled to said multi-media playback unit and to the memory, said controller operable to cause the apparatus, when executing the program instructions, to perform the functions of:

playing back, from the multi-media program material, a first segment of the multi-media program material selected according to a first criteria that is defined according to content of the multi-media program material; and

suppressing playback of a second segment of the multi-media program material selected according to a second criteria that is defined according to the content of the multi-media program material;

playing back, from the multi-media program material, a third segment of the multi-media program material selected according to the first criteria.

40.   The apparatus of claim 38 further including a wireless remote controller, operatively coupled to said first controller, said wireless remote controller capable of receiving information from said first controller and displaying content segments.

41.   The apparatus of claim 40 wherein said wireless remote controller is configured to display segments that contain third party advertising messages.

APPENDIX A

EVIDENCE APPENDIX

[NONE]

RELATED PROCEEDINGS

[NONE]

APPENDIX C